The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NICHOLAS V. PERRICONE

Appeal 2007-3935
Application 10/625,244
Technology Center 1600

Decided: September 6, 2007

Before ERIC GRIMES, LORA M. GREEN, and RICHARD M. LEBOVITZ *Administrative Patent Judges.*

GREEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 10-18 and 21-26. We have jurisdiction under 35 U.S.C. § 6(b). Claims 10, 11, 12, 13 and 15 are representative of the claims on appeal, and read as follows:

10. A method for the reduction of glycation in cells of the skin comprising: applying a composition acting directly upon said skin cells

containing an amount of benfotiamine effective to reduce the quantity of glycated proteins in said skin cells, in a dermatologically acceptable carrier, to skin tissue.

11. A method for the treatment of glycation in cells of the skin comprising: applying a composition acting directly upon said skin cells containing an amount of benfotiamine effective to reduce the quantity of glycated proteins in said skin cells, in a dermatologically acceptable carrier, to affected skin tissue.

12. A method for the treatment of damage to the cells of the skin due to glycation comprising: applying a composition acting directly upon said skin cells containing an amount of benfotiamine effective to reduce formation of glycated proteins in said cells, in a dermatologically acceptable carrier, to skin tissue.

13. A method for the treatment of aging of the cells of the skin due to glycation comprising: applying a composition acting directly upon said skin cells containing an amount of benfotiamine effective to reduce quantity of glycated proteins in said cells, in a dermatologically acceptable carrier, to affected skin tissue.

15. A method in accordance with claims 10, 11, 12, or 13, wherein the composition contains from about .05% to about 70% by weight benfotiamine.

The Examiner relies upon the following references:

Woerwag (as translated)	DE 41 10087 A1	Oct. 1992
Runge	US 6,261,598 B1	Jun. 17, 2001

"Questions & Answers about ... Arthritis and Rheumatic Diseases", 02-4999 *National Institute of Arthritis and Musculoskeletal and Skin Diseases (NIAMS)*, 1-34(2002), http://www.niams.nih.gov/hi/topics/arthritis/artrheu.htm.

We affirm.

BACKGROUND

According to the Specification,

> Glycation of proteins in the cells of the skin causes a loss of skin elasticity and the breakdown of collagen. The immediate effects of glycated proteins include inflammation, wrinkles, and brown spots or lipofuscin. Glycated proteins also produce toxic free radicals which can have multiple damaging effects on cells. The present invention recognizes this process and provides a composition and method to minimize and to treat such glycation damage.

(Specification 3.)

Thus, the claimed invention is drawn to "a topical benfotiamine treatment to improve skin condition by preventing glycation of proteins in cells of the skin." (*Id.*)

DISCUSSION

The Examiner rejected claims 10-18 and 21-26 under 35 U.S.C. § 103(a) as being obvious over the combination of Runge and Woerwag. We find, however, that Runge in fact anticipates claims 10-18 and 21-26, and as "anticipation is the epitome of obviousness," we affirm. *In re McDaniel*, 293 F.3d 1379, 1385, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002) (noting that it is "well-settled that 'anticipation is the epitome of obviousness.'"). But as our reasoning differs from that of the Examiner, and in order to give Appellant an opportunity to respond, we designate our affirmance as a new ground of rejection.

Independent claims 10, 11, 12, 13, 21, 22, 24, 25, and 26 are all drawn to a method of achieving a benefit to the skin, *i.e.*, reduction or treatment of glycation (claims 10, 11, 21, 24, and 26); treatment of damage of cells due to glycation (claims 12 and 25); or treatment of aging of cells due to glycation

(claims 13 and 22), comprising applying a composition containing an effective amount of benfotiamine (or other allithiamine), in a dermatologically acceptable carrier, to the skin.

Runge teaches a composition comprising a carotenoid and at least one other active substance in concentrations of 0.01 to 40% by weight (col. 2, ll. 41-46), wherein the composition may be a cosmetic preparation such as a cream or lotion (reads on a dermatologically acceptable carrier) (col. 4, ll. 33-36). Runge teaches that the other active substance may be allithiamines, such as benfotiamine (col. 3, ll. 3-4). Thus Runge teaches a cosmetic composition comprising benfotiamine, and as it is a cosmetic composition, it would be applied directly to the skin. Moreover, Runge teaches that the benfotiamine may be present in concentrations of 0.01 to 40% by weight, which overlaps with the range in claim 15 of about 0.05% to about 70% by weight, thus Runge teaches using an effective amount of the allithiamine.

The facts in this case are very similar to the facts in *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368 (Fed. Cir. 2005). For example, at issue in that case was a claim drawn to "[a] method for the treatment of skin damaged or aged by oxygen-containing free radicals or oxidative generation of biologically active metabolites which comprises topically applying to affected skin areas a composition containing an effective amount of an ascorbyl fatty acid ester in a dermatologically acceptable, fat-penetrating carrier such that the ester is percutaneously delivered to lipid-rich layers of the skin." *Id.* at 1373. The prior art taught a cosmetic composition for topical application that included ascorbyl palmitate, among many other ingredients. *Id.* at 1376.

The Federal Circuit found that the prior art anticipated the above referenced claim, along with other claims to particular skin benefits achieved by applying the composition to the skin. *Id.* at 1378-79. Specifically, the court found that all skin is subject to damage or aging by oxygen-containing free radicals or oxidative generation of biologically active metabolites, thus all that was required was application of the composition to the skin. *Id.* at 1379-80.

In the instant case, all skin is subject to glycation, with the resultant loss of skin elasticity and the breakdown of collagen. Thus the benefit stated in the preamble of the claims, of reduction or treatment of glycation, treatment of damage of cells due to glycation, or treatment of aging of cells due to glycation, naturally flows from the method of applying the composition of Runge to the skin, *see, e.g.*, *Perricone*, 432 F.3d at 1378, and thus Runge anticipates the subject matter of independent claims 10-13, 21, 22, 24-26, as well as dependent claim 23.

Claim 14 requires an additional ingredient, such as ascorbic acid. As Runge teaches that the composition may contain ascorbic acid, (col. 2, ll. 53-61), Runge also anticipates the method of claim 14.

Claim 15 requires that the composition contain from about 0.05% to about 70% by weight benfotiamine; claim 16 requires that the composition contain from about 5% to about 20% by weight benfotiamine; claim 17 requires that the composition contain from about 0.05% to about 5% by weight benfotiamine; and claim 18 requires that the composition contain from about 0.25% to about 7% by weight benfotiamine. As Runge teaches that the additional ingredient, *i.e.*, benfotiamine, may be present in an amount of of 0.01% to 40% by weight, it anticipates the methods of claims

15-18. *See Perricone*, 432 F.3d at 1377 (finding anticipation even when a prior art range "does not exactly correspond to [the] claimed range," but the prior art "range entirely encompasses, and does not significantly deviate from, [the] claimed ranges.").

CONCLUSION

In summary, we find that Runge anticipates the subject matter of claims 10-18 and 21-26, thus the rejection is affirmed. Because our reasoning differs from that of the Examiner, we designate our affirmance as a new ground of rejection.

Time Period for Response

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

AFFIRMED; 37 C.F.R. § 41.50(b)

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